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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/873,733	06/04/2001	Allen Chang	10010236-1	4762

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[REDACTED] EXAMINER

LE, DAVID Q

[REDACTED] ART UNIT

[REDACTED] PAPER NUMBER

DATE MAILED: 07/13/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/873,733	CHANG, ALLEN	
	Examiner David Q Le	Art Unit 3621	<i>MW</i>

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 05 April 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1,3-5,7-15 and 17-25 is/are pending in the application.
 - 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1,3-5,7-15 and 17-25 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on 04 June 2001 is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 - a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Examiner's Note

1. The Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claims, other passages and figures apply as well. It is requested from the Applicant, in preparing the response, to consider fully the entire references as well as the context of all passages in the cited references as potentially teaching all or part of the claimed inventions.

Drawings

2. In order to avoid abandonment, the drawing informalities noted in the Office Action mailed on 31 December 2003 must now be corrected. Correction can only be effected in the manner set forth in the above noted paper. Contrary to statements made in the Amendment and Response filed on 5 April 2004, no new drawings have been submitted.

Status of Claims

3. Per the Amendment and Response filed on 5 April 2004:

Claims 1, 3, 8, 10-11, and 20 were amended.

Claims 2, 6 and 16 were canceled.

Claims 21-25 were added.

Claims 1, 3-5, 7-15, and 17-25 remain pending.

Response to Request for Consideration

4. The request for consideration in the Amendment and Response filed on 5 April 2004 under 37

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CFR § 1.111 has been considered but is ineffective to overcome the references Biddle et al and David et al, US Patent Application Publications No. US 2002/0107809 A1 and US 2002/0073046 A1, respectively.

Response to Arguments

5. Applicant's arguments with respect to Claims 2, 5, 6, 16, and 17 have been considered but they are not persuasive.

Neither Biddle nor David specifically recites using "receipt codes" stored in a receipt database in an authentication/license verification method for users of protected software. However Biddle discloses and/or teaches all of the following limitations:

a [method/system] of obtaining an authorization code (Abstract; Summary of the Invention) from a vendor data processing system (Fig 1-2, associated text) for activating a software application on a user data processing system (Fig 19, associated text), the method comprising:

establishing a license database (Fig 2: "Vantage Database"; Fig 3A-C, associated text) referencing user data processing systems (Fig 3A: "Machine ID") on which the software application is licensed to execute;

establishing a [license] code database including a plurality of [license] codes, each [license] code indicating a paid license for the software application (Fig 3A: "OrderNumber", "ProductNumber"; "Is Trial"; "Is Floating"; "Is Portable"; "Is Subscription", etc...; associated text – these license code numbers correspond to the claimed "receipt codes" of the instant application);

requesting a user of the user data processing system to transmit a [license] code to the vendor data processing system (Fig 19: "Is There A License?"; associated text);

in response to a [license] code received by the vendor data processing system from a user data processing system, verifying presence of the [license] code in the [license] code databases and in response to the verifying presence of the [license] code, transmitting the authorization code from the vendor data processing system to the user data processing system (Fig 19: "Run Application"; associated text).

Biddle does not recite

including a plurality of internet protocol addresses [in the system's license database];

obtaining the internet protocol address of the user data processing system using the vendor data

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processing system;

if the internet protocol address is recorded in the license database, then transmitting the authorization code from the vendor data processing system to the user data processing system and activating the application with the authorization code;

in response to the internet protocol address not being recorded in the license database, requesting a user of the user data processing system to transmit a receipt code to the vendor data processing system; verifying presence of the receipt code in the receipt code database, and recording the internet protocol address of the user data processing system in the license database.

However Biddle teaches that his system can easily

- a. customize the user information stored in the license databases used for authentication of purchased licenses (Par 14, 18, 57, 58, 59);
- b. customize the scripts used for the authentication of users and their access to protected software (Par 61, 66, 77, 79);
- c. capture users' IP or network addresses (Par 59, 113) for the purpose of further authentication of users and verification of their access to protected software.

David discloses a system in which IP addresses are used for the verification and authentication of users on a network, for the purpose of allowing the users access to protected digital content (Abstract; Summary of the Invention; Par 23, 26, 47, 49).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to include IP addresses as one further element to use in the authentication of users and their access to protected content, as claimed in the instant application, and as amply taught by Biddle, further amplified by the specific embodiments disclosed by David. Such a system would provide added flexibility while maintaining high security for the software to be licensed, eventually increasing user acceptance for the system.

Claim Objections

6. The numbering of claims is not in accordance with 37 CFR 1.126 which requires the original numbering of the claims to be preserved throughout the prosecution. When claims are canceled, the remaining claims must not be renumbered. When new claims are presented, they must be numbered

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consecutively beginning with the number next following the highest numbered claims previously presented (whether entered or not).

Claim 17 is said to dependent on claim 16, which has been canceled. Since the original claim 16 was dependent on claim 11, Examiner has assumed that claim 17 is now dependent on claim 11. Claim 17 should be amended to correct this oversight in the response to this Office Action.

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Biddle et al in view of David, US Patent Application Publications US 2002/0107809 A1 and US 2002/0073046 A1, respectively.

As per claims 1, 8.

Biddle discloses

A [method/system] of obtaining an authorization code from a vendor data processing system for activating a software application on a user data processing system (Abstract, Summary of the Invention), the method comprising:

establishing a license database (Par. 57, Fig 3A-C, associated text);

obtaining the internet protocol address of the user data processing system using the vendor data processing system (Par. 59);

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Biddle does not recite that the user IP address is used as an identifier referencing licensed user systems. However he teaches that machine IDs may be used instead, and that machine IDs will work to trigger license authorization (Fig 19, associated text; see citations used in Response to Arguments), i.e. "an authorization code will be sent to the user system" if the machine ID matches one in the license database. Biddle also teaches that user IP addresses may be easily captured by his system and may be used in log files (Par. 59; see all citations already used above).

David discloses a system for authorizing access to digital content (Abstract; Objects of the Invention; Summary of the Invention) wherein user IP addresses or machine IDs may be used as unique identifiers to authorize access to licensed products and services (Par. 23, 26, 47, 49).

It would have been obvious to one ordinarily skilled in the art at the time the invention was made to have combined the teachings from Biddle and David in order to provide an additional user identifier value – user IP addresses - to accurately reference licensed user computers. Such additional capability would make the licensing management system more versatile and offer more opportunity to verify the identity of users requesting access to licensed software. With the use of this additional identifier, the system will be able to automatically authorize more users faster; it will also, as a result, comprise the remaining limitations of claims 1 and 8 (see Response to Arguments above).

As per claims 3, 11.

Biddle in view of David discloses all the limitations of claim 1 and 10 respectively.

Biddle in view of David further discloses (see all above citations).

... presenting to the user data processing system options for entry of a receipt code or an order form (Fig 19: "Register/Subscribe"; associated text) for the software application

As per claim 10.

Biddle in view of David discloses all the limitations of claim 10 (see all above citations, obviousness and motivation analyses for claims 1, 3, and 8):

A computer implemented method of obtaining an authorization code from a vendor data processing system for activating a software application on a user data processing system, the method comprising:

establishing a license database including a plurality of internet protocol addresses

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establishing a receipt code database ... software application;
referencing user data processing systems on which the software application is licensed to execute;
initiating installation of the software application in the user data processing system;
obtaining the internet protocol address of the user data processing system using the vendor data processing system;
if the internet protocol address is recorded in the license database, then transmitting the authorization code from the vendor data processing system to the user data processing system;
if the internet protocol address is not recorded in the license database, then requesting a user of the user data processing system to transmit a receipt code to the vendor data processing system;
in response to a receipt code ... in the license database.

As per **claims 4, 12.**

Biddle in view of David discloses all the limitations of claim 1 and 11 respectively.

Biddle further discloses

processing a payment by the user for the software application in response to the presented order form (Fig 19-20, associated text).

As per **claims 13.**

Biddle in view of David discloses all the limitations of claim 11.

Biddle further discloses (Fig 20, associated text).

after receiving the authorization code completing installation of the software application.

As per **claims 5 and 14.**

Biddle in view of David discloses all the limitations of claims 1 and 11 respectively.

Biddle further discloses (see all above citations)

identifying a number of available software application licenses corresponding to the user that are not referenced to a particular internet protocol address and user data processing system; and if the internet protocol address is not recorded in the license database, then associating at least one of the available software application licenses with the internet protocol address and transmitting the authorization code from the vendor data processing system to the user data processing system (Par. 59).

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As per claim 17.

Biddle in view of David discloses all the limitations of claim 11.

Biddle further discloses

establishing a receipt code database including a plurality of users each associated with at least one software application license and if the receipt code is recorded in the receipt code database, then transmitting the authorization code from the vendor data processing system to the user data processing system (see all above citations).

As per claims 7, 9, and 19.

Biddle in view of David discloses all the limitations of claims 4, 8, and 12 respectively.

Both references further disclose (see all citations cited above)

processing a payment includes accessing a financial institution data processing system for conducting a payment verification.

As per claims 15 and 18.

Biddle in view of David discloses all the limitations of claims 14, and 17 respectively.

Biddle further discloses (see all above citations)

after obtaining the internet protocol address from the user data processing system:

if the internet protocol address is not recorded, then prior to presenting the order form to the user, performing steps (a) - (c):

- (a) determining availability of at least one software application license corresponding to the user;
- (b) if at least one license is available, then automatically transmitting the authorization code to the user data processing system and recording the internet protocol address in the license database; and
- (c) if at least one the license is not available, then presenting the order form for the software application to the user data processing system.

As per claim 20.

Biddle in view of David disclose (see all above limitations, obviousness and motivation analyses)

A computer implemented method of obtaining an authorization code from a vendor data processing system for activating a software application on a user data processing system, the method comprising:

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establishing a license database ... in the license database.

As per claims 21-25.

Biddle in view of David discloses all the limitations for these claims (see all citations used above, obviousness and motivation analyses for claims 1, 8, 10, and 20, and Response to Arguments).

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David Q Le whose telephone number is 703-305-4567. The examiner can normally be reached on 8:30am-5:30pm Mo-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James P Trammell can be reached on 703-305-9768. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DQL

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